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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/660,579	09/12/2000	Jay S. Walker	96-067X	2261

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STAMFORD, CT 06905

EXAMINER

VU, NGOC K

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 08/24/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/660,579

Applicant(s)

WALKER ET AL.

Examiner

Ngoc K. Vu

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,10-12,14,15,32-36,38,39 and 41-43 is/are pending in the application.
- 4a) Of the above claim(s) 38 and 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,10-12,14,15,32-36 and 41-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4</u> . | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1, 2, 10-12, 14, 15, 32-36 and 41-43, drawn to requesting supplemental information, classified in class 725, subclass 115.
  - II. Claim 38, drawn to editing additional dialogue recorded in a recording medium, classified in class 386, subclass 96.
  - III. Claim 39, drawn to recording synchronization information on a recording medium, classified in class 386, subclass 84.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I, II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because they are separately usable. The subcombination has separate utility such as indicated by the different limitations as outlined in the respective grouping of the different claimed inventions as illustrated above.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II and Group III, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Dean Alderucci on 8/16/04 a provisional election was made without traverse to prosecute the invention of Group I, claims 1, 2, 10-12, 14, 15, 32-36, 39 and 41-43. Affirmation of this election must be made by applicant in replying to this Office action. Claims 38 and 39 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Drawings***

7. The drawings are objected to because all reference numbers in drawings with respect to figure 1 are not disclosed in the specification. For example, figure 1 of drawing illustrates television program with reference number 130, service information with reference number 131 ... etc while the specification describes television program 30, service information 31...etc.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures

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must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Objections***

8. Claim 10 is objected to because of the following informalities: claim 10 recites the limitation "synchronizing the requested information with to an audio component of the broadcast television program..." in lines 12-13. It appears that there is typographical error or missing terms in this limitation. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 10-12 and 32-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 is indefinite because there is no antecedent basis for the limitation "the requested information" in line 12.

Claim 32 is indefinite because there is no antecedent basis for the limitation "the selected supplemental information" in line 10.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Palmer (US 5,438,355 A).

Regarding **claim 1**, Palmer discloses a data processing apparatus for providing supplemental broadcast information (see figure 1), comprising:

a CPU (computer 12);

a storage device (database 20) operatively connected to said CPU (12);

an apparatus (fax/phone switch 18), adapted for communication with said CPU (12), for receiving a request from a caller over a telephone network (receiving a request from a user via telephone line 16) for supplemental information related to a broadcast television program and for replaying the request to said CPU (switch 18 receives a request for information regarding to TV programming and relaying the request to the computer 12 – see figure 1 and col. 1, lines 56-60; col. 2, lines 45-55); and

said storage device storing a program, adapted to be executed by said CPU, for processing the request for supplemental information and for transmitting the requested supplemental information through said apparatus (the database 20 inherently stores a program/software or instruction which can be read by and excused by the computer 12 for processing the request for information regarding to TV programming and for transmitting the requested information through the switch 18 – see figure 1; col. 2, lines 45-55).

Regarding **claim 32**, Palmer discloses a method of receiving supplemental information related to a broadcast television program including an audio component and an video component (receiving information regarding a TV programming including an audio component and a video component – see col. 1, lines 56-61), comprising the steps of:

viewing the broadcast television program (viewing TV programming – see col. 1, lines 56-59);

receiving ordering information for the supplemental information from the broadcast television program (receiving ordering information for the information from TV programming such as program identification codes PIC and console identification codes CIC – see figure 1; col. 2, lines 45-55; col. 3, lines 5-12 and 33-35);

requesting the supplemental information in accordance with the ordering information (requesting computer 12 to retrieve the information regarding TV programming from database 20 in accordance with the ordering information - see figure 1 and col. 1, lines 56-60; col. 2, lines 45-55);

providing selection information (providing a record of a polling choice – see col. 4, lines 22-23);

receiving the selected supplemental information during the broadcast television program (receiving the selected information regarding TV programming during the TV programming – see col. 1, lines 56-61; col. 2, lines 52-55).

### ***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 2, 10-12, 14, 15 and 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palmer (US 5,438,355 A) in view of Field et al (US 4,410,911).

Regarding **claim 2**, Palmer discloses providing the retrieved information regarding the TV programming from the database 20, but does not explicitly disclose the information comprising audio.

However, Field discloses providing additional audio information associated with video program, e.g., one or more foreign language versions of a film soundtrack to subscriber (see col. 5, lines 3-7 and figure 1). Therefore, it would have been obvious to one of ordinary skill in the art to modify the system of Palmer by providing additional audio information as disclosed by Field in order to expand the functionality and services of the interactive system to enhance the television viewing.

Regarding **claim 10**, Palmer discloses a method for providing supplemental information and broadcast television program using a CPU (providing TV program and information regarding to TV programming using a computer 12 - see col. 1, lines 56-61 and figure 1), and a storage device (database 20) operatively connected to the CPU (12) and containing a program adapted to be executed by the CPU for processing a request for supplemental information (the database 20 inherently stores a program/software or instruction which can be read by and executed by the computer 12 for processing the request for information regarding to TV programming - see figure 1; col. 2, lines 45-55), and an apparatus (switch 18) adapted for communicating with the CPU (see figure 1), said method comprising the steps of:

receiving the request for supplemental information from a caller via the apparatus (receiving a request for information regarding the TV programming from a user via the switch 18 - see col. 2, lines 45-55 and figure 1);



receiving selection information from the caller via the apparatus and processing the selection information by having the CPU execute the program (computer 12 receives a request information from the user via switch 18 and processing the request by having the computer 12 execute the instruction – see col. 2, lines 45-55 and figure 1);

communicating the requested information via the apparatus (the retrieved information is sent in response to the request from the user via the switch 18 – see col. 2, lines 52-55).

Palmer does not explicitly disclose receiving synchronization information and synchronizing the requested information with an audio component of the TV program. However, Field discloses that an audio encoder and combiner 12 receives an audio control signal ACTL from an audio encode control 14, and the encoder and combiner 12 combines the normal audio signal associated with video program and additional audio signal to form a composite audio signal under the control of the control signal ACTL (see col. 5, lines 45-48; col. 6, lines 30-34). It would have been obvious to one of ordinary skill in the art to modify the system of Palmer by synchronizing the additional audio signal with normal audio signal associated with video program as disclosed by Field in order to provide the additional audio information concurrently with TV program.

Regarding **claims 11 and 12**, Palmer discloses database 20 management as it relates to billing, viewer habit data, request history, etc (see col. 3, lines 33-40).

Regarding **claims 14 and 15**, it is to be noted that the combined system of Palmer and Field is provided with computer program or software stored on a computer readable medium to make the system perform the functions as discussed in claim 10 above.

Regarding **claim 33**, Palmer discloses that PIC and CIC including program identification information, billing information, phone numbers, credit card numbers, etc (see col. 3, lines 5-12 and 33-35).

Palmer does not explicitly disclose receiving synchronization information related to the broadcast television program. However, Field discloses that an audio encoder and combiner 12 receives an audio control signal ACTL from an audio encode control 14, and the encoder and combiner 12 combines the normal audio signal associated with video program and additional audio signal to form a composite audio signal under the control of the control signal ACTL (see col. 5, lines 45-48; col. 6, lines 30-34). It would have been obvious to one of ordinary skill in the art to modify the system of Palmer by synchronizing the additional audio signal with normal audio signal associated with video program as disclosed by Field in order to provide the additional audio information concurrently with TV program.

Regarding **claims 34-35**, Palmer discloses the payment of interactive services via credit card (see col. 2, lines 3-6; col. 3, lines 33-40).

Regarding **claim 36**, Palmer does not explicitly disclose billing via a telephone bill. Official Notice is taken that it is well known in the art to provide for interactive services via telephone companies as part of a consolidated billing arrangement. It would have been obvious to one of ordinary skill in the art to modify the system of Palmer to do so in order to eliminate the necessity for plural bills.

15. Claims 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palmer (US 5,438,355 A) in view of Kurtz (The New York Times, April 14, 1991, Section 3, page 8 - "Technology; A Way to Hear Stock Quotes While Watching Cartoons").

Regarding **claims 41 and 43**, Palmer discloses an apparatus (see figure 1), comprising:

- a CPU (computer 12);
- a storage device (database 20) operatively connected to said CPU (12);
- an receiver (fax/phone switch 18) for receiving a request for supplemental information related to a television program and for replaying the request to said CPU (switch 18 receives a

request for information regarding to TV programming and relaying the request to the computer 12 – see figure 1 and col. 1, lines 56-60; col. 2, lines 45-55); and

a program, adapted to be executed by said CPU, for processing the request for supplemental information and for transmitting the requested supplemental information (a program/software or instruction which can be read by and excused by the computer 12 for processing the request for information regarding to TV programming and for transmitting the requested information – see figure 1; col. 2, lines 45-55).

Palmer does not disclose the supplemental information comprising supplemental dialogue for a character within the television program and/or descriptive audio version of the television program for the visual impaired.

However, Kurtz discloses in The New York Times article that television station supplies audio descriptions and commentary for visually impaired about some of its program. Namely, during movie “Singing in the Rain”, viewers learned that while Gene Kelly was being filmed singing in the rain, it was actually daytime and sunny. The commentary does not interrupt the dialogue but speaks over it (see “The New York Times” IDS – page 3, 5<sup>th</sup> paragraph; page 4, last paragraph to page 5, 1<sup>st</sup> paragraph). It would have been obvious to one of ordinary skill in the art to modify the system of Palmer by providing audio commentary for a character within showing movie and/or a descriptive audio version of the TV program as disclosed by Kurtz for the visual impaired purpose.

Regarding **claim 42**, Palmer discloses an apparatus (see figure 1), comprising:

a CPU (computer 12);

a storage device (database 20) operatively connected to said CPU (12);

an receiver (fax/phone switch 18) for receiving a request for supplemental information related to a television program and for replaying the request to said CPU (switch 18 receives a

request for information regarding to TV programming and relaying the request to the computer 12 – see figure 1 and col. 1, lines 56-60; col. 2, lines 45-55); and

a program, adapted to be executed by said CPU, for processing the request for supplemental information and for transmitting the requested supplemental information (a program/software or instruction which can be read by and excused by the computer 12 for processing the request for information regarding to TV programming and for transmitting the requested information – see figure 1; col. 2, lines 45-55).

Palmer does not disclose the supplemental information comprising a foreign langue version of the television program.

However, Kurtz discloses in The New York Times article that the television stations supplies Spanish version of television program on secondary audio programming sideband SAP, according to “The New York Times” (see “The New York Times” IDS – page 3, 5<sup>th</sup> paragraph; page 5, 3<sup>rd</sup> paragraph). It would have been obvious to one of ordinary skill in the art to modify the system of Palmer by providing a foreign language version of TV programming as disclosed by Kurtz to offer translations of TV programming in that language.

### ***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Walker et al. (US 6,209,028 B1) disclose a system and method for supplying supplemental audio information for broadcast television programs.

Field et al. (US 4,398,216) disclose multiple signal transmission method and system for television.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc K. Vu whose telephone number is 703-306-5976. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on 703-305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ngoc K. Vu  
Examiner  
Art Unit 2611

2004-08-21